

Application No.10/825,522  
Amendment dated May 18, 2010  
Reply to Office Action of February 19, 2010

### **REMARKS**

Applicant cancelled claims 16-18 without prejudice or disclaimer of their subject matter and amended independent claims 1, 6, and 11 to further define Applicant's claimed invention. No new matter has been added.

#### **Summary of the interview conducted April 7, 2010**

Applicant thanks the Examiner for the courtesy extended during the interview with Applicant's representatives on April 7, 2010. During the interview, Applicant's representatives discussed incorporating the subject matter of dependent claims 16-18 into independent claims 1, 6 and 11, respectively. Applicant's representatives also discussed MPEP § 2136.03(III) in relation to the rejection over U.S. Patent No. 7,534,265 to Boyd et al ("Boyd"). Agreement on the claims was reached.

#### **Remarks in response to the Office Action of February 19, 2010**

In the Office Action, the Examiner rejected claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 5,645,598 to Brosnahan ("Brosnahan") and U.S. Patent No. 5,593,409 to Michelson ("Michelson '409"), and further in view of U.S. Patent No. 4,834,757 to Brantigan ("Brantigan").

Applicant incorporated the subject matter of dependent claims 16-18 into independent claims 1, 6, and 11, respectively. Independent claims 1 and 6, as now amended, each recite providing an implant including "arcuate portions terminating at an edge at the medial side, the opening in the medial side having a height in a plane transverse to the length of the first implant, the edges being spaced apart a distance equal to the height of the opening in the medial side." Independent claim 11, as now amended, recites providing an implant including "arcuate portions terminating at an edge at the medial side, the opening in the medial side having a height in a plane transverse to the length of the body of the first implant, the edges being spaced apart a distance equal to the height of the opening in the medial side." The proposed combination does not teach or suggest such a method.

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Applicant submits that the rejection of independent claims 1, 6, and 11 and claims 2-5, 7-10, and 12-15, dependent from one of independent claims 1, 6, and 11, has been overcome.

The Examiner rejected claims 6, 7, 10-12, 15, 17, and 18 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,534,265 to Boyd et al. ("Boyd"), based on provisional application serial no. 60/115,388; and rejected claims 1-5, 8, 9, 13, 14, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Boyd, based on provisional application serial no. 60/115,388. Applicant respectfully traverses the rejections.

Boyd issued from U.S. Application No. 09/869,813 filed on January 3, 2002 under 35 U.S.C. 371(c)(1), which is based on International Application No. PCT/US00/00604 filed on April 11, 2000 (which claims the benefit of U.S. Provisional Application No. 60/115,388, filed January 11, 1999). MPEP § 2136.03(III) states that international applications which were "filed prior to November 29, 2000 ... may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e)." As the Boyd PCT application was filed prior to November 29, 2000, Applicant submits that the PCT application cannot be used to bridge to the earlier provisional application for purposes of 35 U.S.C. § 102(e). Accordingly, Applicant submits that the rejections of claims 6, 7, 10-12, 15, 17, and 18 and 1-5, 8, 9, 13, 14, and 16 under 35 U.S.C. §§ 102(e) and 103(a), respectively, over Boyd have been overcome.

Applicant submits that independent claims 1, 6, and 11 are patentable and that dependent claims 2-5, 7-10, and 12-15, dependent from one of independent claims 1, 6, and 11, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

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To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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Dated: May 18, 2010

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